

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jae-seong SHIM, et al.

Serial No. 10/830,076

Group Art Unit: 2627

Confirmation No. 7669

Filed: April 23, 2004

Examiner: GUPTA, Parul H.

For: DISC TYPE RECORDING MEDIUM ON WHICH ADDITIONAL INFORMATION IS  
RECORDED BY FORMING DISC TRACK, METHOD OF FORMING DISC TRACK, AND  
RECORDING MEDIUM FOR RECORDING PROGRAMS EXECUTING THE METHOD

**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed March 5, 2007, having a shortened period for response set to expire on April 5, 2007, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect **Group II**, claims 11-36 drawn to a method of forming disc tracks and a computer readable recording medium having the disc tracks, in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Group II is concerned, it is believed that claims 1-10 and 37-44 are so closely related to elected claims 11-36 that they should remain in the same application. The elected claims 11-36 are directed to a method of recording information by forming disc tracks and a disc type recording medium for recording information by forming disc tracks and claims 1-10 and 37-44 are drawn to a disc type recording medium for recording data by forming disc tracks and a method of storing data on a disc by forming data frames, respectively. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing both method and product claims in the same field of technology. While it is noted that the Examiner has identified different classifications for the

product and method claims, it is believed that classification is not conclusive on the question of restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group I and Group III claims by filing a divisional application.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

Even if the Examiner considers claims 1-10 and 37-44 to be a separate invention from claims 11-36, the Applicants respectfully request the Examiner to consider claims 1-10 and 37-44 (Groups I and III) and 11-36 (Group II) together.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the medium and method recited by the Group I and III claims are directed to recording data by forming disc tracks and/or data frames, and elected claims 11-36 are directed to recording information by forming disc tracks, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 503333.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date:

4/5/07

By:



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